

ESTTA Tracking number: **ESTTA645840**Filing date: **12/19/2014**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	General Motors LLC		
Entity	Limited Liability Company	Citizenship	Delaware
Address	300 Renaissance Center Detroit, MI 48265-3000 UNITED STATES		

Attorney information	Karen A. Merkle General Motors LLC 300 Renaissance Center MC#482-C23-B21 Detroit, MI 48265-3000 UNITED STATES karen.a.merkle@gm.com Phone:313-665-0950
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**Registration Subject to Cancellation**

Registration No	4554682	Registration date	06/24/2014
Registrant	Amalie AOC, Ltd. 1601 McCloskey Blvd. Tampa, FL 33605 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 001. First Use: 2006/09/00 First Use In Commerce: 2006/09/00 All goods and services in the class are cancelled, namely: Transmission fluid
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**Grounds for Cancellation**


Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Petitioner as Basis for Cancellation**


U.S. Registration No.	833566	Application Date	03/22/1967
Registration Date	08/15/1967	Foreign Priority Date	NONE
Word Mark	DEXRON		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 1967/03/10 First Use In Commerce: 1967/03/10 AUTOMATIC TRANSMISSION FLUID		

U.S. Registration No.	2044503	Application Date	02/06/1995
Registration Date	03/11/1997	Foreign Priority Date	NONE
Word Mark	DEX-COOL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 001. First use: First Use: 1996/01/19 First Use In Commerce: 1996/01/19 antifreeze and coolant for motor vehicles		

U.S. Registration No.	3929002	Application Date	11/21/2008
Registration Date	03/08/2011	Foreign Priority Date	NONE
Word Mark	DEXOS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 004. First use: First Use: 2010/11/01 First Use In Commerce: 2010/11/01 Engine oil		

U.S. Registration No.	3945278	Application Date	09/16/2009
Registration Date	04/12/2011	Foreign Priority Date	NONE
Word Mark	DEXOS 1		
Design Mark			
Description of Mark	The mark consists of a square containing a swirling design and the number "1" in the lower right corner of the square next to the word "DEXOS".		
Goods/Services	Class 004. First use: First Use: 2010/11/01 First Use In Commerce: 2010/11/01 Engine oil		

U.S. Registration No.	4653624	Application Date	04/05/2013
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Registration Date	12/09/2014	Foreign Priority Date	NONE
Word Mark	DEXOS 2		
Design Mark			
Description of Mark	The mark consists of a square containing a swirling design and the number "2" in the lower right corner of the square next to the word "DEXOS".		
Goods/Services	Class 004. First use: First Use: 2013/12/13 First Use In Commerce: 2013/12/13 Engine oil		

Attachments	77619245#TMSN.png( bytes ) 77827650#TMSN.png( bytes ) 85896087#TMSN.png( bytes ) Petition for Cancellation - Dex III (2) - KAM.pdf(15642 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/KAM/
Name	Karen A. Merkle
Date	12/19/2014

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Registration No. 4,554,682

GENERAL MOTORS LLC,	)	
	)	
Petitioner,	)	
	)	Cancellation No. _____
v.	)	
	)	
Amalie AOC, Ltd., Packers Acquisition Co.	)	
	)	
Respondent.	)	
_____	)	

**PETITION FOR CANCELLATION**

This Petition to Cancel is submitted in the matter of Registration No. 4,554,682, which, according to PTO records, is owned by Amalie AOC, LTD., Packers Acquisition Company, 1601 McCloskey Blvd, Tampa, Florida, 33605. Registration No. 4,554,682 is for the trademark DEX III-H/M for use in connection with “transmission fluid” in International Class 1 and was registered on June 24, 2014. Petitioner, General Motors LLC, a Delaware LLC with a place of business at 300 Renaissance Center, Detroit, Michigan, 48265-3000, believes that it will be damaged by the continued registration of said mark and, therefore, petitions to cancel said registration.

**I. Petitioner’s DEXRON and DEX-COOL trademarks have priority over Respondent’s DEX III H/ M trademark based upon earlier filed Registrations on the Principal Register.**

The grounds for this Petition are as follows:

1. Since the early 1900's, General Motors has been engaged in the manufacture, assembly, distribution and marketing of a wide variety of motor vehicles and their parts, accessories and vehicle fluids including transmission fluid, coolant and engine oil. General Motors is a highly diversified company with numerous operating divisions and wholly-owned subsidiaries. General Motors' products are sold through thousands of motor vehicles dealerships located around the world.
2. On April 4, 2014, General Motors applied for federal registration of the mark DEXCOOL APPROVED and Design in connection with "Antifreeze and coolant for motor vehicles", which application has been assigned Serial No. 86/242526, and on May 16, 2014, General Motors applied for federal registration of the mark DEXSTOP APPROVED and Design in connection with "Brake fluid", which application has been assigned Serial No. 86/283022.
3. On information and belief, Respondent, Amalie AOC, Ltd., Packers Acquisition Co. is a Florida corporation doing business at 1601 McCloskey Blvd, Tampa, Florida, 33605.
4. On June 24, 2014, Respondent obtained a Federal registration for the mark DEX III-H/M, Reg. No. 4,554,682, for "Transmission fluid" in International Class 1.
5. On June 27, 2014, the United States Patent & Trademark Office preliminarily rejected General Motors' applications 86/242526 for DEXCOOL APPROVED and Design and 86/283022 for DEXSTOP APPROVED and Design, based on a likelihood of confusion with Registrant's Registration No. 4,554,682 for DEX III-H/M.

6. General Motors has been the owner of Registration No. 833,566 for DEXRON for “automatic transmission fluid” since March 22, 1967, which predates Respondent’s registration for DEX III-H/M by 47 years; Registration No. 2,044,503 for DEX-COOL for “Antifreeze and coolant for motor vehicles” since February 6, 1995, which predates Respondent’s registration for DEX III-H/M by 19 years; Registration No. 3,929,002 for DEXOS for “Engine Oil” since March 8, 2001, which predates Respondent’s registration by three years; Registration No. 3,945,278 for DEXOS1 and Design for “Engine oil” since April 12, 2011 which predates Respondent’s registration by three years, and a current pending application Serial No. 85/896087 for DEXOS2 and Design for “Engine oil” filed April 4, 2013 for which a Statement of Use is now pending and predates Respondent’s registration by one year.

7. General Motors first adopted and has continuously marketed and used it DEXRON trademark for transmission fluid since as early as 1967, and first adopted and has continuously marketed and used its DEX-COOL trademark for anti-freeze and coolant since as early as 1995. Since that time, General Motors has expanded its diverse product line of motor vehicle fluids to include engine oil under the DEXOS name.

8. Based on General Motor’s use and registration of its DEXRON and DEX-COOL trademarks since 1967 and 1995, respectively, General Motors’ registrations for such marks have priority over Respondent’s registration for DEX III-H/M for transmission fluid.

**II. Respondent's mark DEX III-H/ M is likely to cause confusion with Petitioner's marks DEXRON, DEX-COOL and DEXOS.**

9. As a result of the continuous and extensive use and licensing of General Motors' DEXRON and DEX-COOL trademarks for motor vehicle fluids, such marks have become, and continue to function as extremely valuable business and marketing assets of General Motors. Fluids bearing the DEXRON and DEX-COOL trademarks have come to indicate to the automotive trade and consuming public that such high-quality motor vehicle transmission fluid and coolant, respectively, originate from General Motors and its licensees.

10. General Motors' success in licensing its "DEX" family of marks on motor vehicle fluids approved for sale by General Motors and its licensees further exemplifies the trade and public's association of General Motor's "DEX" family of trademarks with high quality motor vehicle fluids originating from General Motors and its authorized licensees.

11. Due to the similarity between General Motors' prior-registered trademarks DEXRON for transmission fluid and DEXCOOL for coolant and anti-freeze for motors vehicles with Respondent's latter-filed mark DEX III-H/ M for transmission fluid, as well as the similar trade channels and consumers for such goods, purchasers of Respondent's goods and Petitioner's goods are likely to be confused as to the source of the goods at issue.

### III. Damages

12. General Motors LLC will be damaged by the continued registration of Respondent's DEX III-H/M mark for "transmission fluid" on the Principal Register in that General Motors' applications Serial No. 86/242526 to register DEXCOOL APPROVED and Design and Serial No. 86/283022 for DEXSTOP APPROVED and Design will be blocked by Respondent's continued registration of Registration No. 4,554,682.

13. Further, Respondent's mark DEX III-H/M for transmission fluid so closely resembles General Motors' earlier registered marks DEXRON for transmission fluid and DEX-COOL for anti-freeze and coolant for motor vehicles, in sound, appearance, connotation and commercial impression so as to cause a likelihood of confusion under 15 U.S.C. Section 1052(d). Respondent's trademark is likely to confuse, to cause mistake to, or deceive the consuming public as to the source of Respondent's and Petitioner's goods. This confusion, mistake and deception are causing and will continue to cause irreparable damage to Petitioner's business and goodwill.

WHEREFORE, General Motors respectfully requests that this Petition for Cancellation be granted and Registration No. 4,554,682 be canceled.

Respectfully submitted,

Date: December 19, 2014

/Karen A. Merkle/

Karen A. Merkle

*Attorney for Petitioner*

General Motors LLC

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**CERTIFICATE OF TRANSMISSION**

I hereby certify that the foregoing PETITION FOR CANCELLATION is being electronically transmitted via the Electronic System for Trademark Trials and Appeals ("ESTTA") at <http://estta.uspto.gov/> on the date noted below:

Date: December 19, 2014

By: /Karen A. Merkle/  
Attorney for Petitioner,  
General Motors LLC

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing PETITION FOR CANCELLATION is being served upon Respondent's counsel by depositing such copy with the United States Postal Service as first-class mail, postage pre-paid, in an envelope addressed to the following:

Mr. D. Douglas McDonald  
Carlton Fields Jordan Burt  
4221 W. Boy Scout Blvd.  
Suite 1000  
Tampa, FL 33607-5780

Date: December 19, 2014

By: /Karen A. Merkle/  
Attorney for Petitioner,  
General Motors LLC